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Scott Montgomery

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ORRICK, HERRINGTON & SUTCLIFFE, LLP

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MURDOUGH, JOSHUA A

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/990,341	<b>Applicant(s)</b> MONTGOMERY ET AL.	
	<b>Examiner</b> JOSHUA MURDOUGH	<b>Art Unit</b> 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 85-139 is/are pending in the application.
- 4a) Of the above claim(s) 106-123 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 85-105 and 124-139 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 C.F.R. §1.114***

1. A request for continued examination ("RCE") under 37 C.F.R. §1.114, including the fee set forth in 37 C.F.R. §1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 C.F.R. §1.114, and the fee set forth in 37 C.F.R. §1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 C.F.R. §1.114. Applicant's submission filed on 30 June 2008 has been entered.

### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. §121:
- I. Claims 85-105, drawn to a method for operating a postal meter, classified in class 705, subclass 401.
  - II. Claims 106-123, drawn to a method for processing a mail piece, classified in class 705, subclass 62.
  - III. Claims 124-139, drawn to a postal metering system, classified in class 705, subclass 408.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the

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instant case, subcombination II has separate utility such as processing mail that was not pre-processed by a vendor controlled centralized postage issuing system. See MPEP § 806.05(d).

4. Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination III has separate utility such as a postage issuing system where one and two-dimensional barcodes are not printed on the mail piece. See MPEP § 806.05(d).

5. The Examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

6. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;

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- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. §101 and/or 35 U.S.C. §112, first paragraph.

7. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 C.F.R. §1.143) and (ii) identification of the claims encompassing the elected invention.

8. The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

9. If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

10. Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the

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inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

11. The Examiner, upon review of Groups I and III has determined that the system and method, as currently claimed, are not patentably distinct. However, Applicant is advised that an amendment to one group, without a similar amendment to the other could result in patentably distinct groups. Presently, the two Groups will be examined together, as per the conversation with Mark Stirrat (Reg. # 50,756) on 2 September 2008, but the status will be reevaluated after any amendment. The resulting combination of groups is directed toward a system and method for issuing postage (claims 85-105 and 124-139). Affirmation of this election must be made by applicant in replying to this Office action.

12. Claims 106-123 withdrawn from further consideration by the Examiner, under 37 C.F.R. §1.142(b), as being drawn to a non-elected invention.

### *Acknowledgements*

13. To summarize the above:

- a. This action is responsive to the RCE noted above and the supplemental response filed 1 July 2008.
- b. Claims 85-139 are pending.
- c. Claims 106-123 are withdrawn with this action as being directed toward a non-elected invention.
- d. Claims 85-105 and 124-139 have been examined.

***Drawings***

14. The drawings are objected to under 37 C.F.R. §1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “indexing tracking ID request to the USPS” from claim 93 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 C.F.R. §1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 C.F.R. §1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112 2<sup>nd</sup> Paragraph***

15. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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16. Claims 93, 104, 131, and 132 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

17. Claim 93 recites the limitation "a second indexing tracking ID request to the USPS" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim. There is no first indexing tracking ID request to the USPS. However, there is an indexing tracking ID request prior to this limitation. If this is what the limitation was intended to refer to, the Examiner suggests language such as, "a second indexing tracking ID request, which is directed to the USPS"

18. Also, in regards to claims 93, 104, 131, and 132; one of ordinary skill in the art would not understand how a request can be made to a remote system to retrieve something that is generated locally. The "indexing tracking ID" is part of the indicium as shown in claims 85 and 124. The data for the indicium is generated "at a vendor controlled centralized postage issuing computer system." Therefore, the "indexing tracking ID" would be considered part of the "data corresponding to a postage indicium" and thus, it would be understood to originate at the "vendor controlled centralized postage issuing computer system." This position is supported by Figure 13, step 612. However, claims 93, 104, 131, and 132 indicate that the "indexing tracking ID request" is from the "vendor controlled centralized postage-issuing computer system" and "to the USPS." As it is understood to be generated at the "vendor controlled centralized postage-issuing computer system," the request of the "indexing tracking ID" from the USPS makes the scope of this claim indefinite, because the ID appears to originate from two different places. For purposes of prior art, this has been interpreted to be the USPS requesting by the ID, the data to



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verify the indicium from the central server, as this is the most logical request according to the previously established methods.

***Claim Rejections - 35 USC § 102***

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

20. Claims 85-96, 98-105, 124-138, as understood by the Examiner, are rejected under 35 U.S.C. §102(b) as being anticipated by Whitehouse (US 6,005,945).

21. As to claim 85, Whitehouse shows:

e. In a vendor-controlled centralized postage-issuing computer system **102**, a method of processing a mail piece, comprising:

f. generating data corresponding to a postage indicium **215** at a vendor-controlled centralized postage issuing computer system (Figure 6), the postage indicium being associated with a mail piece (printed on it; Column 13, lines 56-60) and configured for processing through the United States Postal Service (USPS) (“The present invention also provides the technical means for postal agencies such as the USPS;” Column 1, lines 43-49);

g. storing the data corresponding to the postage indicium within a database of the vendor- controlled centralized postage issuing computer system (Figure 4, element 174)

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such that an indexing tracking ID (Piece Number/Serial Number, Column 11, line 21) is associated with the data corresponding to the postage indicium and the indexing tracking ID is usable as an index for the data corresponding to the postage indicium (Column 13, lines 38-40);

h. transmitting the indexing tracking ID (as part of the indicium, Column 13, lines 20-22) and the data corresponding to the postage indicium from the vendor-controlled centralized postage issuing computer system to an end user computer **104** (Figure 6);

i. receiving, at the vendor-controlled centralized postage issuing computer system, a postage indicium request transmitted from the USPS **180** (Figure 4 & Columns 8-9, lines 63-12), wherein the postage indicium request contains the indexing tracking ID (serial number; Id.); and

j. retrieving the data corresponding to the postage indicium from the database based on the indexing tracking ID (Id.).

22. As to claims 124, 130, 132, the system as claimed is necessarily present in order for the method of claim 85 to be performed. Therefore, claim 124 is rejected under the same basis as claim 85.

23. As to claims 86 and 125, Whitehouse further shows:

the indexing tracking ID is unique within the USPS for at least one year (unique without a time period is interpreted as being unique for all time periods, which clearly extends past one year; Column 13, lines 38-40).

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24. As to claims 87 and 126, Whitehouse further shows:

the data corresponding to the postage indicium comprises data representative of one or more items selected from the group consisting of postage amount, date and time of postage information creation, service class, optional data advance, and delivery zip code (column 11, lines 18-29).

25. As to claims 88 and 127, Whitehouse further shows:

deriving a digital signature from the data corresponding to the postage indicium (Id.); associating the digital signature with the data corresponding to the postage indicium (“The encryption key ID indicates which key was used to generate the digital signature,” Id.); and storing the digital signature and the data corresponding to the postage indicium within the vendor-controlled centralized postage-issuing computer system (Column 13, lines 38-60).

26. As to claim 89, Whitehouse further shows:

transmitting the digital signature with the data corresponding to the postage indicium from the vendor-controlled centralized postage issuing computer system to the end user computer (Id.).

27. As to claims 90 and 128, Whitehouse further shows:

the digital signature is derived by applying a private key to the data corresponding to the postage indicium (Column 13, lines 41-46).

28. As to claims 91 and 129, Whitehouse further shows:

the digital signature is derived within a physically secure coprocessor device (Id.).

29. As to claim 92, Whitehouse further shows:

receiving, at the vendor-controlled centralized postage-issuing computer system, an indexing tracking ID request from the end user computer prior to storing the data corresponding to the postage indicium within the database of the vendor-controlled centralized postage issuing computer system (Figure 5A, Step 200).

30. As to claims 93 and 131, Whitehouse further shows be the USPS requesting by the ID, the data to verify the indicium from the central server (Figure 8).

31. As to claims 94 and 133, Whitehouse further shows:

allocating the indexing tracking ID at the vendor-controlled centralized postage-issuing computer system in response to the indexing tracking ID request (Figure 5A, Step 210).

32. As to claim 95, Whitehouse further shows:

transmitting, from the vendor-controlled centralized postage-issuing computer system to the USPS, the data corresponding to the postage indicium after retrieving the data corresponding to the postage indicium (Columns 8-9, lines 63-12, inherently, the data has to be retrieved locally before it can be sent to another device).

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33. As to claim 96, Whitehouse further shows:

- k. generating a plurality of postage indicium data sets (in the transaction database 174), each data set comprising data corresponding to a postage indicium associated with a mail piece (column 8, lines 59-62);
- l. associating a plurality of indexing tracking IDs with the plurality of postage indicium data sets (Column 11, lines 10-29); and
- m. storing the plurality of postage indicium data sets within the database **174**.

34. As to claims 98 and 134, Whitehouse further shows:

the postage indicium request is received from the USPS over the internet (Column 8, lines 23-29).

35. As to claim 99, Whitehouse further shows:

transmitting the retrieved data corresponding to the postage indicium from the vendor-controlled centralized postage-issuing system to the USPS over the internet (Figure 4, communications interface 152 being an internet connection).

36. As to claims 100 and 135, Whitehouse further shows:

the indexing tracking ID and the data corresponding to the postage indicium are transmitted to the end user computer in a format that enables the end user computer to print a

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one-dimensional bar code representative of the indexing tracking ID and a two-dimensional bar code representative of the data corresponding to the postage indicium (Column 15, lines 18-21).

37. As to claims 101 and 136, Whitehouse further shows:

transmitting the retrieved data corresponding to the postage indicium over the internet such that the data can be displayed at the USPS (Figure 4, communications interface 152 being an internet connection as stated in Column 8, lines 23-29).

38. As to claims 102 and 137, Whitehouse further shows:

the postage indicium comprises either a meter number or an account number that is not part of the indexing tracking ID (Column 12, lines 57-64).

39. As to claim 103, Whitehouse further shows:

the data corresponding to the postage indicium is a subset (Column 13, Table of indicium elements) of a larger data set corresponding to the postage indicium (Columns 10-11, lines 45-29).

40. As to claim 104, Whitehouse further shows:

the indexing tracking ID and the data corresponding to the postage indicium are transmitted from the vendor-controlled centralized postage issuing computer system to the end user computer over the internet and the postage indicium request is received from the USPS over

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the internet (Figure 4, communications interface 152 being an internet connection as stated in Column 8, lines 23-29).

41. As to claims 105 and 138, Whitehouse further shows:

the data corresponding to the postage indicium comprises a meter number or an account number that is not part of the indexing tracking ID (Column 12, lines 57-64).

***Claim Rejections - 35 USC § 103***

42. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

43. Claims 97 and 139 are rejected under 35 U.S.C. §103(a) as being unpatentable over Whitehouse.

44. As to claims 97 and 139, Whitehouse shows as discussed above, but does not expressly show:

the indexing tracking ID is a USPS delivery confirmation code.

45. Nevertheless, the difference(s) are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data code used. Further, the structural elements remain the same regardless of the specific data code

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used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP, 2106. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Whitehouse to substitute the USPS delivery confirmation code for the piece number or serial number disclosed in order to allow for closer integration with the USPS.

### ***Response to Arguments***

46. The Examiner agrees that the objections to the use of the term “independent” as well as the 35 U.S.C. 112 issues previously presented are moot as the respective claims have been canceled.

47. Applicant's arguments filed 30 June 2008 have been fully considered but they are not persuasive.

48. Applicants argue:

In regards to claims 85, Whitehouse fails to disclose: "receiving, at the vendor-controlled centralized postage issuing computer system, a postage indicium request transmitted from the USPS, wherein the postage indicium request contains the indexing tracking ID; and retrieving the data corresponding to the postage indicium from the database based on the indexing tracking ID." A similar argument is made in respect to claim 124. (Remarks, pages 13-15)



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49. Examiner's response:

The Examiner has cited passages that teach these limitations from claim 85. Additionally, as noted above, the system is necessarily present in order to perform the method. The Examiner acknowledges that a similar limitation was said to not be expressly shown in the previous action. However, in preparing this action, both the reference (Whitehouse) and the instant application have been reviewed, providing the Examiner with a better appreciation of what is being claimed and what is taught by the reference.

50. Applicants other arguments are in reference to the application of Bailey, which has not been relied on for the current rejections, or they are to claim 106, which has been withdrawn. Therefore, the arguments are considered moot at this time.

***Definitions***

51. To the extent that the Examiner's interpretations are in dispute with Applicants' interpretations, the Examiner hereby adopts the following definitions—under the broadest reasonable interpretation standard—in all his claim interpretations.<sup>1</sup> Moreover, while the following list is provided in accordance with *In re Morris*, 127F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997), the definitions are a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

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<sup>1</sup> While most definition(s) are cited because these terms are found in the claims, the Examiner may have provided additional definition(s) to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

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***Can:*** “1...f : be inherently able or designed to.” Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

***Enable:*** “1 a : to provide with the means or opportunity... b : to make possible, practical or easy” Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-3270. The examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

J. M.

Examiner, Art Unit 3621

/ANDREW J. FISCHER/

Supervisory Patent Examiner, Art Unit 3621